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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,659	02/26/2002	Tomohiro Nishi	450100-03743	8660
20999	7590	06/21/2005		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER YENKE, BRIAN P	
			ART UNIT 2614	PAPER NUMBER

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/085,659

Applicant(s)

NISHI ET AL.

Examiner

BRIAN P. YENKE

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2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Terminal Disclaimer (03 Mar 05).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Terminal Disclaimer*

1. The terminal disclaimer filed on 03 Mar 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,674,561 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (see below) of copending Application No. 10/385225. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons indicated below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In considering claim 1,

*a) the claimed periodically modulating...* is met by copending claim 1, limitation a.

Although, the copending claims does not recite "luminance", the periodic modulation of a signal (i.e. for piracy recording etc...) can be performed on the chrominance and/or luminance components of the signals, and thus they are not patentably distinct.

*b) the claimed optical state variation...* is met by copending claim 1, limitation b.

In considering claim 2,

*a) the claimed when said luminance modulation...* is met by copending claim 4.

*b) the claimed said first condition...* is met by copending claim 4.

It is noted that the copending claim 4 does not recite "first condition" however, the claim does recite what the condition is as claimed in pending claim 2, thus the limitation is met.

In considering claim 3,

*a) the claimed in addition to said first condition...* is met by copending claim 5.

*b) the claimed said second condition...* is met by copending claim 5.

It is noted that the copending claim 5 does not recite "second condition" however, the claim does recite what the condition is as claimed in pending claim 3, thus the limitation is met.

In considering claim 4,

*a)-b) the claimed said luminance modulation...* is met by copending claim 6.

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It is noted that the copending claim 6 does not recite "first condition" however, the claim does recite what the condition is as claimed in pending claim 4, thus the limitation is met.

In considering claim 5,

*a)-b) the claimed said first condition...is met by copending claim 7.*

It is noted that the copending claim 7 does not recite "second condition" however, the claim does recite what the condition is as claimed in pending claim 5, thus the limitation is met.

In considering claim 6,

*The claimed said luminance modulation...is met by copending claim 8.*

In considering claim 7,

*The claimed said luminance modulation...is met by copending claim 9.*

In considering claim 8,

*The claimed said luminance modulation...is met by copending claim 1. Although, copending claim 1 does not state "same display luminance", it would be recognized by one skilled in the art to realize that if the display luminance is not to be changed since the modulation is not to hamper the directly viewed image, the luminance of the original image would be unaltered (i.e. the same before/after modulation).*

In considering claim 9,

*The claimed said optical state variation...is met by copending claim 11.*

In considering claim 10,

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Is met by copending claim 12. Also, see claim 1 on luminance.

In considering claim 11,

Is met by copending claim 28. Also, see claim 1 on luminance

In considering claim 12,

Is met by copending claims 14 and 16. Also, see claim 1 on luminance

In considering claim 13,

Is met by copending claim 27. Also, see claim 1 on luminance.

In considering claim 14,

Is met by copending claim 28. Also, see claim 1 on luminance.

In considering claim 15,

Is met by copending claim 29. Also, see claim 1 on luminance.

In considering claim 16,

Is met by copending claim 12. Also, see claim 1 on luminance.

In considering claim 17,

Is met by copending claim 28. Also, see claim 1 on luminance.

In considering claim 18,

Is met by copending claims 19 and 24. Also, see claim 1 on luminance.

In considering claim 19,

Is met by copending claim 27. Also, see claim 1 on luminance.

In considering claim 20,

Is met by copending claim 28. Also, see claim 1 on luminance.

In considering claim 21,

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Is met by copending claim 29. Also, see claim 1 on luminance.

In considering claim 22,

Is met by copending claims 19 and 24. Also, see claim 1 on luminance.

In considering claim 23,

Is met by copending claims 19 and 24. Also, see claim 1 on luminance.

### Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Yenke whose telephone number is (571)272-7359. The examiner work schedule is Monday-Thursday, 0730-1830 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John W. Miller, can be reached at (571)272-7352.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703)305-HELP.

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(FAX) 703-305-7786

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The Patent Electronic Business Center (EBC) allows USPTO customers to retrieve data, check the status of pending actions, and submit information and applications. The tools currently available in the Patent EBC are Patent Application Information Retrieval (PAIR) and the Electronic Filing System (EFS).



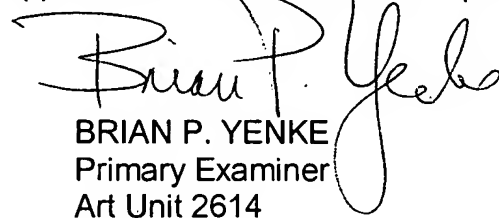
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B.P.Y

18 June 2005



BRIAN P. YENKE  
Primary Examiner  
Art Unit 2614